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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/300,930	04/28/1999	JEFFREY T. PACHL	OB003JP-3	5002

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EXAMINER
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ZEMEL, IRINA SOPJIA

ART UNIT	PAPER NUMBER
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1711

DATE MAILED: 06/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/300,930

Applicant(s)

PACHL ET AL.

Examiner

Irina S. Zemel

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 25 February 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-41 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-41 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |                                                                                                                                             |                                                                                         |
|---------------------------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                                                                            | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                                        | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>6-7-99</u> . | 6) <input type="checkbox"/> Other: _____                                                |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 37-39 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The rejection of claims 37-39 as containing new matter stands as per reasons of record.

### ***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1- are rejected under 35 U.S.C. 103(a) as being unpatentable over Carey in combination with Wycech and Kagoshima.

The rejection of all pending claims stands as per reasons set forth in the previous office actions.

### ***Response to Arguments***

Applicant's arguments filed on October 15, 2004 and February 25, 2005 have been fully considered but they are not persuasive. In response to applicants arguments

that claim 37-39 do not present new matter because Figure 1 and examples 18-24 show some reaction times that are lower than 100 sec, the examiner wishes to point out that the claimed range of "less than 100 seconds" is inclusive of ALL reaction times including reaction times well below the times shown on Figure 1 and the references examples, and therefore, the claimed range as a whole presents a new matter since there is no evidence on the record that the applicants were in possession of the entire claimed range at the time the invention was made.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

The applicants point out the differences between the claimed invention and the inventions disclosed in each reference individually. See pages 10-11 of both the October 15, 2004 and February 25, 2005 responses. However, the rejections set forth in the previous office actions are clearly based on the combined teaching of the references. Moreover, the secondary references were cited by the examiner exactly for the reasons that they contain some of the differences and that the differences are known in the art and, thus, modification of the primary reference in view of the differences taught in the secondary reference would have been obvious. For example, applicants attack the difference of a single phase system of Carey and a two-phase system of Wycech. If applicants turn to pages 2-3 the rejection dated 3-16-200 they

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may note that the teachings of Wycech reference were cited precisely for that reason – to show that two-phase systems are known and offer some advantages over the one phase systems. The same reasoning applies to the differences of Carey and Kagoshima and other differences of Wycech, such as chemical blowing agents. The reason the secondary references were cited is to provide evidence that use of chemical blowing agents and heat is also known in the art of epoxy foams and each variation offers some advantage or improvement. It is very old and notoriously known in the general area of chemical reactions that varying reaction conditions such as amounts of reactants, temperatures, pressures, etc., shifts chemical equilibrium and offers control over a reaction. The cited secondary references were provided as evidence of such knowledge, and also, the differences between the cited references were discussed at length in the numerous previous office actions. In response to applicant's argument that all three references is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, all three references clearly are in the same field of endeavor and all are pertinent to the epoxide foams. Thus, the teachings of the references is properly combinable.

Further, in response to the argument that the cited references fail to teach dispensing of the foam, applicants attention is drawn to Carey column 11, Method 2 that starts with "A machine method for continuous dispensing of foam...: (emphasis added).

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Moreover, all the claim limitation is required is that "a foam" is dispensed into "a cavity". This step does not require any particular foam characteristics, and clearly uncured foams satisfy the claim limitation. Further, this step does not even have to precede, the way claim 1 (and all other independent claims) is drafted, step (b), and, therefore, any material that can be plausible qualified as foam (before or after foaming with the chemical foaming agent). For that matter, placing a foam into ANY cavity (such as a plastic bag or a box for further transporting the foam) inherently meets the claimed limitation of dispensing. Furthermore, applicants attention is drawn to the disclosure of, for example, Kagashima, who expressly teaches (columns 6-8 and 11) that the foams are suitable for laminated products and for use in wide variety of applications including packaging and automotive, where, the foamed materials are inherently dispersed into a cavity (a box or inside of a car).

Therefore, the invention as claimed is still considered to have been obvious over the combined teachings of the three cited references.

Applicants should note that certain claims contain various deficiencies such as claim 33 depends on itself; claim 23 refers to a static mixer of claim 9, but no static mixer is claimed in any of the claims, etc. Applicants are advised to carefully review and revise all of the pending claims in view of numerous amendments to the claims. Further, since the pending claims have been amended number of times and the scope of the claimed subject matter is different from the scope of the originally restricted

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claims, an obviousness type double patenting rejection of some of the currently pending claims over the claims of the patent 6,444,713 issued on the parent application.

Further, applicants request to consider the parent applications and references submitted in IDS in the parent applications is acknowledged. While the examiner has considered the parent applications and the references provided in the parent applications to the extent it was necessary to the examination of the instant application and to the extent such consideration is required by MPEP, applicants should note should the instant application mature onto a patent, NONE of the references cited in the parent applications will appear on the front page of the patent unless a proper IDS that includes PTO-1449 list of the references is submitted in the *instant* application.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Irina S. Zemel whose telephone number is (571)272-0577. The examiner can normally be reached on Monday-Friday 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on (571)272-1078. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ISZ

  
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Supervisory Patent Examiner  
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